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| 10/736,223 | 12/15/2003 | Venkat Selvamanickam | 1014-SP165-US | 3138 |
| 34456 7590 12/18/2007 LARSON NEWMAN ABEL POLANSKY & WHITE, LLP 5914 WEST COURTYARD DRIVE SUITE 200 AUSTIN, TX 78730 | | | EXAMINER TALBOT, BRIAN K | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/736,223 | Applicant(s) SELVAMANICKAM, VENKAT | |
| | Examiner Brian K. Talbot | Art Unit 1792 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

1. The amendment filed 10/22/07 has been considered and entered. Claim 6 has been canceled. Claims 1-5 and 7-18 remain in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 1-5,8-13,15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weismann et al. (6,794,339) in combination with either deBarbadillo, II et al. (4,962,085) or Yoshida (5,206,216) further in combination with Lee et al. (2004/0163597) further in combination with Reeves et al. (2005/0014653).

Weismann et al. (6,794,339) teaches synthesis of YBCO using sub-atmospheric processing. Weismann et al. (6,794,339) teaches forming crystalline YBCO that includes forming a precursor film and heat treating at a temperature above 500°C in the presence of oxygen, nitrogen and water vapor at sub atmospheric pressures (abstract). Weismann et al. (6,794,339) teaches water vapor pressures of up to 25 Torr as well as a carrier gas such as nitrogen with the addition of oxygen (col. 2, lines 5-15). By products are swept out of the chamber in a more efficient manner (col. 2, lines 50-60). The growth rate ranges from 1-20 angstroms per second (col. 4, lines 20-22). The substrates on which the superconducting films are deposited on include nickel coated with a buffer of cerium oxide (col. 7, lines 10-20). Sub-

atmospheric pressure of 1-760 Torr are utilized in the processing chamber (Fig. 4 and col. 8, lines 35-45).

Weismann et al. (6,794,339) fails to teach this process utilized in coating tapes.

DeBarbadillo, II et al. (4,962,085) teaches production of oxidic superconductors by zone oxidation of a precursor alloy. This oxidation post-treatment can be performed on a variety of substrate shapes including tapes, ribbons and wire (abstract, Fig. 1 and col. 1, lines 1-15).

Yoshida (5,206,216) teaches a method of fabricating oxide superconducting wires by laser ablation. The superconducting coating is applied to wires or tape-like substrates and post-treated in an oxygen atmosphere to form the superconductor coating (abstract and Fig. 3).

Therefore it would have been obvious for one skilled in the art at the time the invention was made to have modified Weismann et al. (6,794,339) process by utilizing the process to form superconducting materials in tape/ribbon form as evidenced by deBarbadillo, II et al. (4,962,085) or Yoshida (5,206,216) with the expectation of achieving similar success.

Weismann et al. (6,794,339) in combination with either deBarbadillo, II et al. (4,962,085) or Yoshida (5,206,216) fail to teach the use of a showerhead to supply the oxygen/water vapor.

Lee et al. (2004/0163597) teaches the conventionality of supply "forming gases" by a showerhead including oxygen to a substrate to form a superconductive film ([0003]-[0004]).

Therefore it would have been obvious at the time the invention was made to have modified Weismann et al. (6,794,339) in combination with either deBarbadillo, II et al. (4,962,085) or Yoshida (5,206,216) process by incorporating showerhead to supply the oxygen/water vapor as evidenced by Lee et al. (2004/0163597) with the expectation of achieving similar success.

Weismann et al. (6,794,339) in combination with either deBarbadillo, II et al. (4,962,085) or Yoshida (5,206,216) further in combination with Lee et al. (2004/0163597) fail to teach the translating rate of 10 m/h.

Reeves et al. (2005/0014653) teaches a method of forming superconducting articles and XRD methods of characterizing the same. The deposition process includes PLD and CVD ([0037]). The translation rate of the tape substrate is 0.3 meters – 10 meters/h ([0063]).

Therefore it would have been obvious for one skilled in the art at the time the invention was made to have modified Weismann et al. (6,794,339) in combination with either deBarbadillo, II et al. (4,962,085) or Yoshida (5,206,216) further in combination with Lee et al. (2004/0163597) semiconductor coating process by incorporating a translating speed of 10m/h as evidenced by Reeves et al. (2005/0014653) with the expectation of achieving similar success, i.e. a higher throughput.

With respect to claim 13 which recites a pumping system to remove by-products, it is noted that Weismann et al. (6,794,339) teaches by products being swept out of the chamber in a more efficient manner (col. 2, lines 50-60) and hence, the addition of a pumping system to perform this function would be within the skill of one practicing in the art.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weismann et al. (6,794,339) in combination with either deBarbadillo, II et al. (4,962,085) or Yoshida (5,206,216) further in combination with Lee et al. (2004/0163597) further in combination with Reeves et al. (2005/0014653) still further in combination with Manabe et al. (6,774,088) or Weinstein (6,083,885).

Weismann et al. (6,794,339) in combination with either deBarbadillo, II et al. (4,962,085) or Yoshida (5,206,216) further in combination with Lee et al. (2004/0163597) further in combination with Reeves et al. (2005/0014653) fail to teach the processing chamber having a dew point between 40-80°C.

Manabe et al. (6,774,088) teaches a rare earth barium copper compositions and method of producing superconductors. Manabe et al. (6,774,088) teaches dew point temperatures of 80°C when heating the superconducting precursor to form the superconductor. This can be done in reduced pressure (col. 4, lines 40-65 and Examples 2,4).

Weinstein (6,083,885) teaches method of forming textured high temperature superconductors. Weinstein (6,083,885) teaches REBCO superconductors where the precursors are heated in an oxygen atmosphere with a dew point in the range of 20°C-75°C (col. 11, lines 10-45).

Therefore it would have been obvious for one skilled in the art at the tie the invention was made to have modified Weismann et al. (6,794,339) in combination with either deBarbadillo, II et al. (4,962,085) or Yoshida (5,206,216) further in combination with Lee et al. (2004/0163597) further in combination with Reeves et al. (2005/0014653) process by performing the post-treatment having a dew point as claimed as evidenced by Manabe et al. (6,774,088) or Weinstein (6,083,885) with the expectation of achieving similar success.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weismann et al. (6,794,339) in combination with either deBarbadillo, II et al. (4,962,085) or Yoshida (5,206,216)

further in combination with Lee et al. (2004/0163597) further in combination with Reeves et al. (2005/0014653) further in combination with Ott et al. (5,278,138).

Weismann et al. (6,794,339) in combination with either deBarbadillo, II et al. (4,962,085) or Yoshida (5,206,216) further in combination with Lee et al. (2004/0163597) further in combination with Reeves et al. (2005/0014653) fail to teach the processing chamber being a cold-walled chamber.

Ott et al. (5,278,138) teaches an aerosol CVD deposition of a metal oxide film. The metal oxide film can be superconductive coating such as YBCO (col. 3, lines 15-35). The reactors for which the process can take place include both cold-wall and hot-wall reactors (col. 5, lines 50-60).

Therefore it would have been obvious for one skilled in the art at the time the invention was made to have modified Weismann et al. (6,794,339) in combination with either deBarbadillo, II et al. (4,962,085) or Yoshida (5,206,216) further in combination with Lee et al. (2004/0163597) further in combination with Reeves et al. (2005/0014653) process chamber to be a cold-wall chamber as evidenced by Ott et al. (5,278,138) with the expectation of achieving similar success.

Response to Amendment

4. Applicant's arguments filed 10/22/07 have been fully considered but they are not persuasive.

Applicant argued that the prior art teaches an *in situ* process whereas the claimed process is an *ex situ* process, i.e. a MOD process and not a PVD or CVD process.

The Examiner disagrees. The primary reference to Weismann et al. (6,794,339) is a MOD process and therefore would be an *ex situ* process as argued by Applicant.

Applicant argued Weismann et al. (6,794,339) failed to teach a translating tape and a showerhead, deBarbadillo, II et al. (4,962,085) or Yoshida (5,206,216) fail to teach a MOD process, Lee et al. (2004/0163597) failed to teach a translating process and MOD and Reeves et al. (2005/0014653) failed to teach a MOD process.

The Examiner agrees in part. It has been well settled that pointing out the differences between the reference and each individual reference is not sufficient to overcome a rejection based on a combination of the references. One cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 208 USPQ 871 (CCPA 1981); *In re Merck & Co., Inc.*, 231 USPQ 375 (Fed. Cir. 1986). Furthermore, the test of obviousness is not express suggestion of the claimed invention in any or all references but rather what the references taken collectively would suggest to those of ordinary skill in the art presumed to be familiar with them. *In re Rosselet*, 347 F.2d 847, 146 USPQ 183 (CCPA 1965); *In re Hedges*, 783 F.2d 1038.

In this case the Examiner has provided motivation to combine the references as applied in the rejection above. Furthermore, it is the Examiner's position that the reasons for combining the references would be applicable in the static or dynamic coating process as these features or benefits are not exclusive of the process. It is noted that the reasons to combine the references

do not have to be the same as the instant application. In response to applicant's argument that the applicant has a different reason for, or advantage resulting from doing what the prior art relied upon has suggested, it is noted that it is well settled that this is not demonstrative of non-obviousness, *In Re Kronig* 190 USPQ 425, 428 (CCPA 1976); *In Re Lintner* 173 USPQ 560 (CCPA 1972); the prior art motivation or advantage may be different than that of applicant while still supporting a conclusion of obviousness. *In Re Wiseman* 201 USPQ 658 (CCPA 1979); *Ex Parte Obiaya* 227 USPQ 58 (Bd. of APP. 1985).

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Talbot whose telephone number is (571) 272-1428. The examiner can normally be reached on Monday-Friday 8AM-4PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 12/14/07
Brian K Talbot
Primary Examiner
Art Unit 1762

BKT